

Remarks

Claims 1-17 were pending in the application. Claims 10-13 and 17 have been withdrawn from consideration by the Examiner, and claims 1-9 and 14-16 stand rejected.

By this paper, claims 1 and 14 have been amended, and reconsideration of the claims is respectfully requested. Furthermore, claims 10-13 and 17 have been cancelled, and new claims 18-22 have been added.

Applicants' attorney left a message for the Examiner on June 28, 2007, but as of the filing date of this paper, we have not heard back from the Examiner. Applicants' attorney remains available to discuss the application at the Examiner's convenience.

Rejection Under 35 U.S.C. § 112

Claims 1-9 and 14-16 were rejected under § 112, second paragraph, as being indefinite. More specifically, claims 1 and 14 were each rejected because the Examiner believes that the terms "eligibility" and "eligible" are "not defined by the claim and thus it is unclear which transactions are or are not subject to the claim limitations." Furthermore, claims 1 and 14 were rejected under § 112, second paragraph, "as being incomplete for omitting essential steps, such omission amounting to a gap between the steps." More specifically, the Examiner noted that claims 1 and 14 each reference "a transaction decision regarding payment via the bank account," and asserted that "it is unclear from prior claim limitations what transaction decision is referred to." The Examiner also raised the following question: "How is the transaction processed and settled?"

Regarding the terms "eligibility" and "eligible," Applicants respectfully believe that those terms are clear and definite. In that regard, claim 1 recites the step of "determining eligibility of the transaction for payment via a bank account," and claim 14 recites "instructions for determining eligibility of the transaction for payment via a bank account."

Examples of how eligibility may be determined are disclosed in the application. For example, as disclosed on page 7 of the application, "the authorization host 36 may determine eligibility based on bank account rules developed by the authorization host 36 and/or provided by the financial institution 38." As another example, which is also disclosed on page 7, "the authorization host 36 may communicate with the financial institution 38 to determine if sufficient funds exist in the bank account."

Claims 1 and 14 each further require providing (claim 1) or instructions for generating (claim 14) an authorization response that includes "a unique transaction identifier if the transaction is eligible for payment via the bank account," and receiving (claim 1) or instructions for receiving (claim 14) an electronic response packet "if the transaction is eligible for payment via the bank account." Thus, Applicants respectfully believe that it is clear which transactions are or are not subject to the claim limitations.

Regarding the claim term "transaction decision," Applicants also believe that this term is clear. In that regard, as required by each of claims 1 and 14, the term "transaction decision" pertains to "payment via the bank account." In other words, the term "transaction decision" refers to a decision regarding whether or not payment via the bank account is to occur. In order to further clarify the term, however, claims 1 and 14 have each been amended to recite that the transaction decision pertains to "whether or not the check transaction is to proceed with payment via the bank account." Please see page 8 of the application, lines 13-15, for support for this amendment.

Regarding the Examiner's question as to how the transaction is processed and settled, Applicants respectfully believe that no additional features or steps are required in either claim 1 or claim 14. Furthermore, Applicants wish to direct the Examiner's attention to dependent claims 7-9, which recite features associated with transaction settlement.

Rejection Under 35 U.S.C. § 103

Claims 1-9 and 14-16 were rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,053,607 ("the '607 patent") in view of U.S. Publication No. 2001/0037299 ("the '299 publication").

Applicants respectfully believe that the rejection is improper. In that regard, claim 1 recites the step of "receiving an electronic response packet that is transmitted by the terminal if the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding whether or not the check transaction is to proceed with payment via the bank account." Likewise, claim 14 recites "instructions for receiving an electronic response packet provided by the terminal if the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding whether or not the check transaction is to proceed with payment via the bank account." As noted by the Examiner, the '607 patent fails to disclose the above features. Furthermore, the '299 publication fails to cure the deficiencies of the '607 patent. For example, contrary to the Examiner's assertion, the '299 publication does not disclose use of an electronic response packet that includes a unique transaction identifier provided with an authorization response, and a transaction decision regarding whether or not the transaction is to proceed with payment via a bank account. Thus, the combination of the '607 patent and the '299 publication falls short of the invention claimed in either claim 1 or claim 14. As a result, claims 1 and 14, as well as the associated dependent claims, are believed to be allowable.

Applicants also disagree with the Examiner's assertion that each "if" phrase of claims 1 and 14 is optional language and that there is "not a positive limitation recited." To the contrary, each "if" phrase requires that certain limitations be met in the event the condition following the term "if" occurs. For example, claims 1 and 14 each require that the authorization response include a unique transaction identifier "if the transaction is eligible for payment via the bank account." As another example, claims 1 and 14 each require receiving

(claim 1) or instructions for receiving (claim 14) an electronic response packet “if the transaction is eligible for payment via the bank account.” Rather than including optional language, as asserted by the Examiner, claims 1 and 14 each recite conditional expressions. It is believed to be improper to ignore this language as the Examiner proposes.

New Claims

New claims 18 through 22 have been added for consideration by the Examiner. Because claims 18-19 and 20-21 depend from claims 1 and 14, respectively, claims 18-21 are believed to be allowable for at least the reasons discussed above concerning the corresponding independent claims.

New claim 22 recites the step of “receiving an electronic response packet that is transmitted by the terminal when the transaction is eligible for payment via the bank account, the response packet including the unique transaction identifier and a transaction decision regarding whether or not the check transaction is to proceed with payment via the bank account.” Because this step, in combination with the other steps recited in claim 22, is not disclosed in the cited references, claim 22 is believed to be allowable.

Conclusion

Applicants have made a genuine effort to respond to each of the Examiner’s objections and rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is invited to contact the undersigned at his earliest convenience.

S/N: 09/992,596
Reply to Office Action of April 3, 2007

Atty Dkt No. FDC 0164 PUS

The \$120.00 one-month extension fee is being submitted herewith. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978.

Respectfully submitted,

Mario P. Manfre et al.

By 

Mark E. Stuenkel

Reg. No. 44,364

Attorney/Agent for Applicant

Date: July 24, 2007

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351